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EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,142

Applicant(s)

RATHUS ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 168-289 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 168-289 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Amendment filed 02 December 2002.

### *Obviousness-Type Double Patenting*

2. Claims 168, 284 and 287 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter '863).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 168, 284 and 287 of the instant application, Applicants claim a system for **displaying programming** material to a user, the system comprising "a **printed** photograph having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said machine recognizable feature and a **means for transmitting a coded signal** in response to the recognition of said machine recognizable feature", "an **intelligent controller** having associated therewith a **means for accessing** said programming material in response to receiving said coded signal", ... and "a **display unit** for presenting said programming material". The '863 patent discloses a system for **displaying programming** to a user, the system comprising, among other things, "a **printed stationery** having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said feature and a **transmitter a coded signal** in response to the recognition of said feature", "an **intelligent controller** having associated therewith a **means for accessing** said programming material", ... and "a **display unit** for presenting said programming material". Although the scope of claims 168, 284 and 287 of the present application and claim 1 of '863 patent are almost identical, the difference between the present claimed invention and the '863 patent is

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that the present claimed invention is a broader recitation of the '863 patent (e.g., the present claimed invention recites "a **display unit** for presenting said programming material, etc." whereby the '863 patent recites "a **display unit** for presenting said programming material, ... wherein said display unit comprises a personal computer, etc.")). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claim 1 of '863 patent as a general teaching for having a system for **displaying programming** to a user with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

### ***Provisional Obviousness-Type Double Patenting***

3. Claims 168-220, 242-245 and 253-289 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-221 and 224-263 of copending Application No. 09/769,149 (hereinafter '149).

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Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 168-220, 242-245 and 253-289 of the instant application, Applicants claim a system for **displaying programming** to a user, the system comprising "a **printed photograph** having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said feature and a **means for transmitting a coded signal** in response to the recognition of said feature", "an **intelligent controller** having associated therewith a **means for accessing** said programming material in response to receiving said coded signal", ... and "a **display unit** for presenting said programming material". The method of providing a user access to programming material, comprising the steps of "imprinting a **machine recognizable feature**", "scanning said machine recognizable feature", "transmitting data associated with said machine recognizable feature". The '149 patent discloses a system for **displaying programming** to a user, the system comprising "a **printed stationery** having at least one **machine recognizable feature**", "a **feature recognition unit** having associated therewith a **means for recognizing** said feature and a **means for transmitting a coded signal** in response to the recognition of said feature", "an **intelligent controller** having associated therewith a **means for accessing** said programming material in response to receiving said coded signal", ... and "a **display unit** for presenting said programming material". The method of providing a user access to programming material, comprising the steps of "imprinting a **machine recognizable feature**", "scanning said machine recognizable feature", "transmitting data associated with said machine recognizable feature". Although the scope of claims 168-220, 242-245 and 253-289 of the present application and claims 168-221, 224-263 of '149 application are almost identical, the difference between the present claimed invention and the '149 application is that the present claimed invention is a narrower recitation of the '149 application (e.g., the present claimed invention recites "a **printed photograph** having at least one machine recognizable feature, etc." whereby the '149 application recites "a **printed**

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**stationary** having at least one machine recognizable feature, etc.”). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 168-221, 224-263 of ‘149 application as a general teaching for having a system for **displaying programming** to a user with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 168-173, 176-178, 195-196, 220-241, 255-258, 263-265, 268, 279, 284 and 286-289 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al (US 4,488,035) in view of Fields (US 4,481,412) and Utsugi (US 4,601,573).

Re claims 168-173, 176-178, 195-196, 220-241, 255-258, 263-265, 268, 279, 284 and 286-289: Withnall et al discloses a system for displaying information to a user comprising a printed document having at least one machine recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the information on the portable handset illuminated display having a microprocessor with programmable memories (col. 5, lines 10-17).

Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal.

Fields teaches the above limitation with an accessing means 10 having a microcontroller 23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for transmitting/accessing the programming material in response to receiving the coded signal (fig. 2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a video/image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall et al in order to provide Withnall et al with a higher technology system wherein the user being provided with a full complete

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information in a flexible ways (i.e., video, pictorial, etc.). Furthermore, such modification would have been an obvious extension as taught by Withnall et al, and therefore an obvious expedient.

Withnall et al as modified by Fields fails to teach or fairly suggest that the printed document is a printed photograph.

Utsugi teaches the above limitation with a printed photograph A having a barcode 14 for encoding information related to the photograph (e.g., photograph quality, location, photographer's name, etc.) (See fig. 3 and col. 4, lines 2-22).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Utsugi into the teachings of Withnall et al/Fields in order to provide Withnall et al/Fields with a capability of retrieving data related to a desired photograph readily from the barcode. Furthermore, such modification would provide Withnall et al/Fields with a more secure system for photograph's authorization, preventing fraudulent use in duplicating photographs (i.e., famous photographs/paintings, etc.). Accordingly, such modification would have been an obvious extension as taught by Withnall et al/Fields, and therefore an obvious expedient.

7. Claims 174-175, 180-181, 183-184, 189-190, 192-193, 214-219 and 246-252 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Utsugi as applied to claim 168 above, and further in view of Roberts (US 5,324,922) and Malec et al (US 5,287,266). The teachings of Withnall et al as modified by Fields and Utsugi have been discussed above.

Re claims 174-175, 180-181, 183-184, 189-190, 192-193, 214-219 and 246-252: Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest feature for online/home shopping and the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).



It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of Withnall et al/Fields/Utsugi with the latest technology for a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi to provide the user an alternative way of doing shopping (i.e., shopping online/at home), and therefore an obvious expedient.

Withnall et al/Fields/Utsugi as modified by Roberts fails to teach or fairly suggest that the data link comprises an ISDN line.

Malec et al teaches the above limitation with the use of ISDN technology (col. 7, lines 1-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec et al into the teachings of Withnall et al/Fields/Utsugi/Roberts in order to provide Withnall et al/Fields/Utsugi/Roberts with the latest technology for a more accurate and faster system due to the benefit of ISDN networking line. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi/Roberts and would have mere been a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

8. Claims 179, 182, 286-288, 191, 194, 199-201, 203-204, 209-210, 213, 242-245, 253-254, 262, 267, 269-271, 282 and 285 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Utsugi as applied to claims 168 and 284 above, and further in view of Bravman et al (US 5,401,944). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 179, 182, 286-288, 191, 194, 199-201, 203-204, 209-210, 213, 242-245, 253-254, 262, 267, 269-271, 282 and 285: Withnall et al/Fields/Utsugi have been discussed above but fails to teach or

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fairly suggest that the displayed information including specific details related to traveling (e.g., seat location, departure terminal, hotel, restaurant, etc.), wherein the display unit comprising a wireless communication device (e.g., a remote unit).

Bravman et al teaches the above limitation with remote units 15 providing all necessary information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through col. 14, line 5 and col. 16, line 14 through col. 18, line 22.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman et al into the teachings of Withnall et al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with a more flexibility system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi, and therefore an obvious expedient.

9. Claims 197, 202 and 205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields/Utsugi as applied to claim 168 above, and further in view of Anmelder (DT 2,452,202 A1). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 202, 207 and 205, Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall et al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user.

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Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi, and therefore an obvious expedient.

10. Claims 198 and 212 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields/Utsugi as applied to claim 168 above, and further in view of Tannehill et al (US 5,158,310). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 198 and 212, Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a magnetic code/strip.

Tannehill et al teaches the above limitation with the machine recognizable feature can be a barcode or a magnetic strip (col. 18, lines 7-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill et al into the teachings of Withnall et al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with an alternative feature for encoding data. Furthermore, such modification would have mere been a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

11. Claims 206-208 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields/Utsugi as applied to claim 168 above, and further in view of Schach et al (US 5,397,156) and Anmelder (DT 2,452,202 A1). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 206-208 and 211, Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that.

Schach et al teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schach et al into the teachings of Withnall et al/Fields/Utsugi aesthetic purpose. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi, and therefore an obvious expedient.

Withnall et al/Fields/Utsugi as modified by Schach et al fails to teach or fairly suggest that at least one machine recognizable feature comprises an invisible watermark.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall et al/Fields/Utsugi/Schach et al in order to provide Withnall et al/Fields/Utsugi/Schach et al with a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi/Schach et al, and therefore an obvious expedient.

12. Claims 185, 259-261, 263, 267, 272-278, 280-281 and 283 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields as applied to claim 168 and 301 above, and further in view of Morales (US 5,872,589). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 185, 259-261, 263, 267, 272-278, 280-281 and 283: Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that the display unit comprises a personal planner/phone/pager.

Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7, line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of Withnall et al/Fields/Utsugi in order to provide the user with the flexibility of selecting his/her desired display unit that is fitting his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi, and therefore an obvious expedient.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 168-301 have been considered but are moot in view of the new ground(s) of rejection.

Newly cited reference to Withnall et al, Fields, Bravman et al, Utsugi, Anmelder, Tannehill et al, Malec et al, Schach et al, Morales and Roberts have been used in the new grounds of rejection to meet the newly submitted priority date of the application.

14. In response to the Applicant's argument with regard to "... this application and the copending '149 application both have an effective filing date of May 25, 1994. Since any patents issued from either application will automatically end on the same date, Applicant respectfully submits that a terminal disclaimer is not required..." (p. 6, 3<sup>rd</sup> paragraph), the examiner respectfully disagree, true, their terms may end on the same date but the "other" purpose of a double patenting/terminal disclaimer is to ensure that the "same" invention is not in two different patents which can be bought or sold separately.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Kazumi (US 5,181,062); Matsumoto (US 4,659,213); Ikenoue et al (US 5,168,303); Poor (US 5,452,379); Hakamatsuka et al (US 5,410,642); Ashida et al (JP 03,174,693); Tanaka et al (JP

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07,056,941); Hirata (JP 02,103,025); Oki (JP 02,127,792) are cited as of interest and illustrate a similar structure to a method and apparatus for accessing electronic data via a familiar printed medium.

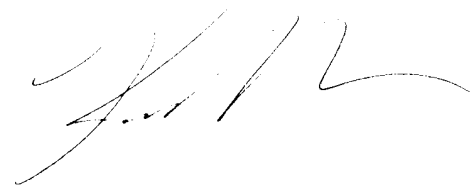
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M, T, F, SUN: 9:30-7:00 and SAT: 1:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen-Chau N. Le*

February 20, 2003



KARL D. FRECH  
PRIMARY EXAMINER